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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,401	09/28/2000	Pekka Koponen	557.301US01	8265

7590   06/30/2005

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EXAMINER
COULTER, KENNETH R

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 April 2005 (RCE and Amendment)</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *14 and 24* is/are allowed.

6)☒ Claim(s) *1-8,10,11,16-23 and 25-39* is/are rejected.

7)☒ Claim(s) *9,12,13 and 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/1/05</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1 – 8, 10, 11, 16 – 23, and 25 – 39 are rejected under 35 U.S.C. 102(e)

as being anticipated by <u>Sherman et al.</u> (U.S. Pat. No. 6,647,409) (Maintaining a Sliding

View of Server Based Data on a Handheld Personal Computer).

2.1   Regarding claim 1, <u>Sherman</u> discloses a method for providing reference

information to a user of a wireless terminal capable of operating within a wireless

network, comprising:

receiving a user-entered request identifier at the wireless terminal which

identifies desired reference information corresponding to the request (col. 9, lines 44 -

53);

determining whether the desired reference information is locally stored at the

wireless terminal (Fig. 6; col. 10, lines 7 – 43 "If the decision module 226 determines

that the **server item is not on the H/PC 22**, i.e., the identification element for the

server-based item does not match any of the **identification elements on the local list,**

the operation flow branches NO from the decision module 226 to request header

operation 234. Request operation 234 **requests the header from the server** for the

server-based item. In response, the **server returns only the *header* for the item**.");

presenting the desired reference information via the wireless terminal if the

desired reference information is locally stored at the wireless terminal (Fig. 6, item 226;

col. 10, lines 7 - 18);

transmitting the request identifier from the wireless terminal to a data server

operating within a second network via a gateway bridging the wireless network and the

second network, if the desired reference information is not locally stored at the wireless

terminal (Fig. 6; col. 10, lines 7 - 43);

presenting the desired reference information obtained from the data server (Fig.

4, item 208; col. 10, lines 7 - 43).

2.2   Per claim 2, <u>Sherman</u> does not explicitly teach providing navigational software

delivered at least in part via a WAP service to the wireless terminal, to facilitate entry of

the request identifier and transmission of the request identifier to the data server if

desired reference information is not locally stored at the wireless terminal.

Sherman does disclose that the "email server may communicate with the H/PC 22 using

either POP, IMAP, or **some other protocol**." (col. 4, lines 10 – 13).

However, WAP (wireless application protocol) is a commonplace protocol for wireless

devices.

Therefore, the use of WAP does not represent a patentably distinct feature over the

prior art of record.

2.3   Regarding claim 3, Sherman discloses locally storing the reference information

obtained from the data server at the wireless terminal (col. 10, lines 35 - 36).

2.4   Per claim 4, Sherman teaches that storing the reference information at the

wireless terminal further comprises monitoring at least one predetermined storage

condition indicative of whether to locally store the reference information obtained from

the data server at the wireless terminal (col. 10, lines 35 - 40).

2.5   Regarding claims 5 – 8, 10, 11, and 16, the rejection of claims 1 – 4 under 35

USC 102(e) (paragraphs 2.1 – 2.4 above) applies fully.

However, Sherman does not explicitly disclose specifics involving determining if

sufficient local storage exists; determining the most frequently requested request

identifiers; initiating default activities upon fulfillment of the predetermined activity

condition; and the reference information being dictionary definitions or language

translations.

Sherman represents a portable device with limited local storage that is connected (by

wireless connection) to a network with larger storage resources.

These specifics are commonplace applications implemented in portable devices with

limited local storage and slow download speed from the wireless network.

Therefore these specifics represent no patentably distinct feature over the prior art.

2.6   Per claims 17 – 23 and 25 – 39, the rejection of claims 1 – 8, 10, 11, and 16

under 35 USC 102(e) (paragraphs 2.1 – 2.5 above) applies fully.

Response to Arguments

3.   Applicant's arguments filed 4/1/2005 have been fully considered but they are not

persuasive.

Applicant states that "the system of Sherman does not teach of suggest, for example,

transmitting the request identifier from the wireless terminal to a data server if the

desired reference information is not locally stored." (Arguments of 4/1/2005; p. 12;

paragraph 3).

Examiner disagrees.

Sherman clearly teaches requesting the reference information (header) from the server

if the reference information is not stored locally ("If the decision module 226 determines

that the **server item is not on the H/PC 22**, i.e., the identification element for the

server-based item does not match any of the **identification elements on the local list**,

the operation flow branches NO from the decision module 226 to request header

operation 234. Request operation 234 **requests the header from the server** for the

server-based item. In response, the **server returns only the *header* for the item.**")

(col. 10, lines 7 – 17; Fig. 6, items 226, 234).

Allowable Subject Matter

4.   Claims 9, 12, 13, and 15 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

5.   Claims 14 and 24 are allowed.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenneth R. Coulter whose telephone number is 571

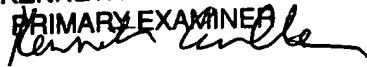272-3879. The examiner can normally be reached on 5 4 9.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER

krc